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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,229	07/06/2000	Tomonari Sendai	Q58683	4828
7590 02/08/2005 Sughrue Mion Zinn MacPeak & Seas PLLC 2100 Pennsylvania Avenue NW Washington, DC 20037-3202			EXAMINER SMITH, RUTH S	
			ART UNIT 3737	PAPER NUMBER

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/611,229	Applicant(s) SENDAI ET AL.	
	Examiner Ruth S Smith	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,12-18,20,26,28,34,36,42,50 and 60 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19,21,22,27,29,30,37,38,43,44,51,52,61 and 62 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8,9,11,45,46,48,49,54-56,58,59 and 64-66 is/are rejected.
- 7) ☒ Claim(s) 24,25,32,33,40 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

Claims 1,3,4,6,35,53,55,56,63,66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to disclose a range of 400-410 nm for the excitation light wavelength. Applicant provides an example of 400 nm and another example of 410 but fails to set forth the entire range.

Claim Objections

Claims 7,10,23,31,39,47,57 are objected to because of the following informalities: In claim 7, line 7 appears to be redundant in view of line 6. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 3737

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,3,4,6,45,46,54-56,64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission of the prior art in view of Tischler et al. Applicant discloses that it is known to use a diagnostic instrument for acquiring fluorescence emitted from a sample by irradiation of excitation light to obtain information regarding the sample. Applicant further discloses that the prior art instrument is incorporated into an endoscope, colposcope etc. The prior art device includes visible light irradiation means and means for forming an image from this light. The excitation light is used during a blanking period when the visible light is not being used. Tischler et al disclose the use of a GaN-based laser that can have application as an excitation source for spectroscopic analysis (Column 7, lines 38-45). Tischler discloses that the materials used for the GaN- based laser can operate in the blue range which encompasses 400-410nm. In the absence of any showing of criticality or unexpected results the specific portion of the blue light range selected would have been obvious to one skilled in the art. Tischler et al disclose that all possible crystal forms are included. It would have been obvious to one skilled in the art to have modified the prior art device disclosed by applicant such that it includes the laser disclosed by Tischler et al. Such a modification merely involves the substitution of one well known type of excitation source in a spectroscopic system for another. With regard to claim 3, it is well known in that art to use either pulsed excitation and the choice of such would have been obvious in that it is a well known expedient in the art. With regard to claims 45,46,54,55, the features concerning a visible light irradiation means and the formation of a normal image and the fluorescence image are set forth by applicant as being known. See pages 2-4 of applicant's specification.

Claims 8-9,11,48,49,58,59,66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission of the prior art in view of Tischler et al as

applied to claims 3,4 above, and further in view of Studholme et al. Studholme et al disclose a fluorescence observing device. Column 8, lines 27-60 refer to how the laser is driven in accordance with the limitations set forth in claims 8,9,11. It would have been obvious to one skilled in the art to have further modified the prior art device such that the laser is driven as disclosed by Studholme et al. Such a modification merely involves the substitution of one known manner in which to drive the laser during operation for another.

Allowable Subject Matter

Claims 24,25,32,33,40,41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 19,21-22,27,29-30,37,38,43,44,51-52,61-62 are allowable over the prior art of record.

Claims 7,10,23,31,39,47,57 would be allowable if rewritten or amended to overcome the objections set forth in this Office action.

Response to Arguments

Applicant's arguments filed 10/12/04 have been fully considered but they are not persuasive. Applicant's arguments regarding claims 45,46 and 54 are not understood in that applicant discloses that it is known in the prior art to provide use the excitation source during blanking periods of the visible light source in the generation of both fluorescent images and normal images. With regard to the Studholme reference, the examiner did not set forth that the laser used by Studholme should be used but that the driving parameters are known and that the laser disclosed by Tischler can be modified to be driven as disclosed by Studholme and that such a modification merely involves the substitution of one known manner in which to drive the laser during operation for

another. It should be noted that applicant fails to set forth how the changes to claim 1 define over the prior art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S Smith whose telephone number is (571) 272-4745. The examiner can normally be reached on M-F 7:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (571) 272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ruth S. Smith', with a stylized, cursive script.

Ruth S Smith
Primary Examiner
Art Unit 3737

RSS